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/Kevin G. Rooney/ January 4, 2007
Kevin G. Rooney, Reg. No. 36,330 Date

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Edwin J. Hlavka et al.
Ser. No.:	10/622,207
Filed:	July 18, 2003
Group Art No.:	3739
Examiner:	William H. Matthews
For:	METHOD AND APPARATUS FOR PERFORMING CATHETER-BASED ANNULOPLASTY
Confirmation No.:	4023
Atty Ref.:	MICO-06C

Cincinnati, Ohio 45202 January 4, 2007

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

RESPONSE TO ADVISORY ACTION AND SECOND REQUEST FOR WITHDRAWAL OF PREMATURE FINALITY OF OFFICE ACTION

This responds to the Examiner's Advisory Action mailed on December 14, 2006. In that Advisory Action, the Examiner checked boxes 3, 8 and 13 to support his decision not to enter and consider the Amendment filed on November 14, 2006. Applicants' counsel traverses this action by the Examiner and requests a substantive response in order to advance prosecution in accordance with the MPEP. In this same connection, Applicants' counsel requests that the finality of the Office Action mailed on July 14, 2006 be withdrawn.

The Advisory Action of December 14, 2006

By checking box 3 on the Advisory Action form, the Examiner states: "The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because they raise new issues that would require further consideration and/or search (see NOTE below)". No "NOTE" was provided by the Examiner. Moreover, this statement by the Examiner simply does not apply to Applicants' Amendment of November 14, 2006 as that response contained no amendments that "raise new issues that would require further consideration and/or search." In fact, the only action taken in that response with respect to the claims was the cancellation of claims 44, 68 and 70. These claims were canceled to further simplify the issues.

By checking box 8 in the Advisory Action, the Examiner states that the "affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 C.F.R. 1.116(e)." This also fails to apply to Applicants' Amendment filed on November 14, 2006 as that response did not include any "affidavit or other evidence" (underlining added) within the meaning of 37 C.F.R. 1.116(e). Instead, in the Amendment filed on November 14, 2006, three claims were canceled and Applicants' counsel requested that the Examiner specifically set forth how the Brock et al. '169 publication qualifies as a reference under 35 U.S.C. § 102(e). That is, the Examiner failed to provide the required facts showing that the Brock et al. '169 publication is a proper reference under 35 U.S.C. § 102(e). See, for example, MPEP §

706.02(f)(1). Therefore, Applicants have a right, prior to resorting to an appeal in this application, to know precisely how the Brock et al. '169 publication qualifies as a reference under 35 U.S.C. § 102(e) and the Examiner's Office Actions and Advisory Action fail to provide that *prima facie* evidence.

Finally, on the continuation sheet of the Advisory Action, the Examiner states: "Applicant has not provided a showing of why the request after Final Rejection could not have been provided earlier, such as in the response filed 5-19-06. Furthermore, as described in MPEP 714.13(II), the current request requires more than a cursory review by the Examiner." In response to the Examiner's first comment, Applicants' response filed May 19, 2006 was limited to a request to withdraw the finality of the premature final rejection mailed by the Examiner on May 4, 2006. This type of request is specifically provided for in MPEP § 706.07(d). The point of that request was to quickly obtain a decision from the Examiner on whether or not the finality was to be withdrawn so that a full and fair opportunity to respond could then be properly addressed by the Applicants based on the provisions in the Federal Rules and MPEP. The Federal Rules and MPEP would then dictate how Applicants may respond to the final action (if maintained) or a non-final action, and/or whether a petition to withdraw finality would be appropriate. In response to Applicants' request the Examiner did withdraw the finality but issued a simultaneous final action asserting that this was proper since Applicants did not file a substantive response simultaneously with the request to withdraw the finality of the office action. Applicants' counsel finds no basis in the MPEP to support the Examiner's issuance of an immediate, second final action in that situation. Applicants' counsel requests that the Examiner provide such basis especially

in light of his improper refusal to enter Applicants' most recent Amendment. Applicants should have been entitled to a decision regarding the finality of the office action prior to preparation of a full, substantive response. Indeed, the type of response appropriate after a final action may be very different from the response filed after a non-final action.

Moreover, with regard to the Examiner's second statement on the continuation sheet, MPEP § 714.13(II) does not stand for the proposition broadly asserted by the Examiner that any response requiring "more than a cursory review by the Examiner" will not be responded to in a substantive manner. In all of these regards, the Examiner appears to be twisting and/or adding provisions to the MPEP. Applicants' amendments of November 14, 2006 did, in fact, merely cancel claims and this is set forth as an explicit instance in MPEP § 714.13(1) and 37 C.F.R. § 1.116 which mandates entry of the Amendment.

Finally, if the Examiner continues to refuse to address the Remarks filed in the Amendment of November 14, 2006, he will still have to address the question on appeal and either withdraw the rejection or maintain the appeal. Why is it that the Examiner will not address the very basic request made in the response filed November 14, 2006? The information should be readily available to the Examiner if the required facts were considered while constructing the rejection of the claims under 35 U.S.C. § 102(e). That is, the effective date of the reference under 35 U.S.C. § 102(e) should have been specifically determined by the Examiner prior to issuance of the rejection. This is a core responsibility of the Examiner and it seems appropriate and reasonable to request information in that regard whether before or after a final Office Action.

Withdrawal of Finality of Office Action dated July 14, 2006

Especially in light of the Examiner's refusal to enter Applicants' response filed on November 14, 2006, as well as the Examiner's comments on the continuation sheet of the Advisory Action mailed on December 14, 2006, Applicants' counsel requests that the finality of the July 14, 2006 Office Action be withdrawn. MPEP §§ 706.07(d) and 706.07(e) are directed to the procedure for withdrawal of the finality of a final rejection. Section 706.07(d) simply states that "[i]f, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection." The form paragraph cited in MPEP § 706.07(d) specifically sets forth the appropriate response to a request for reconsideration of finality: "Applicant's request for reconsideration of the finality of the rejection of the last Office Action is persuasive and, therefore, the finality of that action is withdrawn." These sections of the MPEP do not mandate that Applicant must also simultaneously file a substantive response to the premature final rejection or risk an immediately issued new final rejection nor do they mandate or even condone an immediate, second final Office Action in response to a stand-alone request to withdraw the finality of a premature final rejection. Applicants' counsel can locate no other section in the MPEP that addresses these issues. Absent any other citation in the MPEP or Federal Rules, Applicants' counsel submits that the Examiner should have merely withdrawn the finality of the premature final Office Action and allowed Applicants to then respond to the non-final Office Action accordingly under the provisions for filing a response to a non-final Office Action. Thus, again, the finality of the second final

Office Action issued by the Examiner on July 14, 2006 was premature and should be withdrawn.

If the Examiner believes any matter requires further discussion, the Examiner is respectfully invited to telephone the undersigned attorney so that the matter may be promptly resolved.

Applicants do not believe that any fees are due in connection with this response. However, if such petition is due or any fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Respectfully submitted,

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